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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,911	08/27/2001	Scot D. Wilce	G08.003	5297

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EXAMINER

SHAH, ANKEETA

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/939,911	Applicant(s) WILCE ET AL.	
	Examiner Ankeeta Shah	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-23 and 41-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 24-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-23 and 41-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>01/11/2005</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/27/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-16 and 24-40 been canceled.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-23 and 41-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claim 17-23 and 41-51 do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use a pencil and paper.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-23, 41-44 and 46-55 rejected under 35 U.S.C. 103(a) as being unpatentable over Whitesage (PGPUB 2002/0010686) in view of Fino et al. (Hereafter Fino, PGPUB 2003/0172006)

Re Claim 17 and 55: Whitesage discloses: A method and medium storing instructions for utilizing an agreement modeling system, comprising: receiving an indication of an agreement between a party and a counter-party (see page1, [0006]), the agreement including an agreement term associated with a term date (see claim 36); receiving an indication of a transaction associated with a transaction date (see claim 34);

Whitesage does not disclose: receiving an indication of a query date, the query date being a date other than the date on which the indication of the query date was received; and determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date and the query date.

Fino discloses: receiving an indication of a query date (see Fig 5J, contract details as of the specified date), the query date being a date other than the date on which the indication of the query date was received (i.e. contract details as of the specified dates,

see Fig5H); and determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date and the query date (i.e. reviewing the contract, see [0049])

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method for agreement modeling system of Whitesage by adapting the teaching of Fino to provide the user more options to view the status of his contract.

Re Claim 18: Whitesage further discloses: The method, wherein the term date comprises at least one of: (i) a term effective date (see [0080]), (ii) a term expiration date, (iii) a term period, or (iv) a term entry date.

Re Claim 19: Whitesage does not disclose: The method, wherein the query date comprises at least one of: (i) a date indicated by a user, or (ii) a date associated with a transaction.

Fino discloses: The method, wherein the query date comprises at least one of: (i) a date indicated by a user, or (ii) a date associated with a transaction (see Fig 5H).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method for agreement modeling system of Whitesage by adapting the teaching of Fino to provide the user more options to view the status of his contract.

Re Claim 20: Whitesage further discloses: The method, wherein the indication of the agreement comprises at least one of: (i) an agreement identifier, (ii) a document identifier, (iii) a party entity identifier (see [0040]), (iv) a counter-party identifier, (v) a financial instrument identifier, or (vi) a financial product identifier.

Re Claim 21: Whitesage further discloses: The method, wherein at least one receiving comprises receiving information from at least one of: (i) a user (see [0133]), or (ii) a satellite system.

Re Claim 22: Whitesage further discloses: The method, further comprising: transmitting an indication of applicability to at least one of: (i) a user(see [0164]), or (ii) a satellite system.

Re Claim 23: Whitesage further discloses: The method, further comprising: transmitting an indication associated with a supporting agreement document (see [0064]).

Re Claim 41: Whitesage further discloses: The method, further comprising: receiving transaction information associated with the transaction and the agreement (see [0129]); determining agreement information via an agreement modeling system (see [0148]); evaluating the transaction information and the agreement information (see claim 3); and generating an indication based on said evaluating (see [0064]).

Re Claim 42: Whitesage further discloses: The method; wherein said receiving comprises receiving the transaction information from at least one of: (i) a user (see [0133]), or (ii) a satellite system.

Re Claim 43: Whitesage further discloses: The method, wherein the satellite system comprises at least one of: (i) a business system, (ii) a legal system, (iii) a compliance

system, (iv) a credit system (see [0141]), (v) a treasury system; or (vi) an operations system.

Re Claim 44: Whitesage further discloses: The method, wherein the transaction information is associated with at least one of: (i) a party entity (see [0061]), (ii) a counter-party, (iii) the transaction date, (iv) an agreement date, (v) a financial product, or (vi) a monetary amount.

Re Claim 46: Whitesage does not discloses: The method, wherein the financial instrument comprises at least one of: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and (xiii) a contract for differences instrument.

Fino discloses: The method, wherein the financial instrument comprises at least one of: a loan instrument (see [0041]).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method for agreement modeling system of Whitesage by adapting the teaching of Fino to provide the user more options for financial transactions.

Re Claim 47: Neither Whitesage nor Fino discloses: The method, wherein the agreement information is associated with a covered products matrix.

However it is well known to one having ordinary skill in the art at the time of invention was made that agreement information can be associated with a covered products matrix.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Whitesage and Fino to provide a visual option.

Re Claim 48: The method, wherein the indication comprises at least one of: (i) an indication of approval(see [0071]), (ii) an indication of non-approval, (iii) an indication that further evaluation is required, and (iv) an indication that an amendment to an agreement is required.

Re Claim 49: The method, wherein said generating comprises transmitting the indication to at least one of: (i) a user(see [0164]), and (ii) a satellite system.

Re Claim 50: The method, wherein the transaction comprises at least one of: (i) a pending transaction (see [0188]), and (ii) a completed transaction

Re Claim 51: The method, wherein said evaluating is performed on at least one of: (i) a transaction basis, and (ii) a batch of transactions(see [0061]).

Re Claim 52: Whitesage further discloses: An apparatus for utilizing an agreement modeling system, comprising: a processor (see [0086]); and a storage device in communication with said processor and storing instructions adapted to be executed by said processor to (see claim 52): receive an indication of an agreement between a party and a counter-party (see col 2, [0006]), the agreement including an agreement term associated with a term date (see claim 36); receive an indication of a transaction associated with a transaction date (see claim 34);

Fino discloses: receiving an indication of a query date (see Fig 5J, contract details as of the specified date), the query date being a date other than the date on which the

indication of the query date was received (i.e. contract details as of the specified dates, see Fig5H); and determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date and the query date (i.e. reviewing the contract, see [0049])

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method for agreement modeling system of Whitesage by adapting the teaching of Fino to provide the user more options to view the status of his contract.

Re Claim 53: Whitesage further discloses: The apparatus, wherein said storage device further stores an agreement information database (see abstract).

Re Claim 54: Whitesage further discloses: The apparatus, further comprising: a communication device coupled to said processor and adapted to communicate with at least one of: (i) a client device, (ii) an agreement modeling system controller (i.e. a system administrator see [0065]), (iii) a satellite system, and (iv) a counter-party device.

5. Claim 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Whitesage in view of Fino as applied to claim 44, and further in view of Huberman (USPAT 5,826,244).

Neither Whitesage nor Fino discloses: The method, wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a

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commodity product, (xi) a metal product, (xii) a energy product, and (xiii) an agriculture product.

Huberman discloses: The method, wherein the financial product comprises at least one of: a commodity product (see column 19, lines 3-4)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Whitesage and Fino by adapting the teaching of Huberman to provide user with more options for financial products.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (703)305-0853. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703)308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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